

PATENT  
APPLICATION NO. 09/553,941

## REMARKS

In the present patent application, claims 1-5, 8, 9 and 11-27 are pending. In the office action, all pending claims are rejected. By way of the present amendment, claims 28, 29 and 30 have been added and claims 1, 8, 9, 11 and 21 are amended. As a result, claims 1-5, 8, 9 and 11-30 are at issue.

Applicant has amended claims 1, 8, 9, 11 and 21 to include clarify that all the devices are devices of the automation environment, and the designated functions are the designated functions of the devices in the automation environment. Applicant has also added new claims 28-30 to specify that the automation environment comprises a factory automation environment. The support for the new claims can be found on p.5, lines 7-15. No new matter has been introduced.

Claims 1, 8, 9, 11, and 21 are rejected by the examiner under 35 U.S.C. § 103 as being anticipated by Glorikan (US Patent 6,343,317) in further view of Fukui (US Patent 6,131,1119). This rejection is improper, because neither reference can provide all of the limitations of the claims in the present application.

Each of claims 1, 8, 9, 11, and 21 contain the limitation of "an automation environment". Neither Glorikan nor Fukui contains references to "an automation environment". Each is in different fields. Glorikan is from the "Internet services and business models" field (Column 1 line 6-11). Fukui is from the "in-flight entertainment" field (column 3 line 52). Fukui does discuss an automatic configuration system as noted by the Examiner in the "Response to Arguments". However, this is not an "automation environment". The environment of Fukui is

PATENT  
APPLICATION NO. 09/553,941

an airplane (column 3 line 52). The fact that something does "automatic configuration" does not mean that it is an "automation environment" as in the present invention. The description of an automation environment can be found throughout the specification of the present invention, especially on page 1 lines 13-24. An example of the automation environment is described on page 5, lines 7-15. As described, one device may perform a metal stamping function and another device may perform a metal surface polishing function in a coordinated way, in a timely manner as required by a particular automation environment. The polishing function cannot be carried out prior to the stamping function, for example. Because of the need of coordination, the network device must have the ability to communication with other network devices in the same environment. The context is not of an airplane environment, wherein one passenger may like to watch one TV channel while the other may watch another channel or listen one of the music channels. The display of TV images on one monitor and the display of TV images on another monitor are virtually independent events in that when a passenger turns off his TV monitor, he does not have to know whether his action affects what other passengers' doing. In contrast, shutting off one device in an automation environment may affect a number of other devices. As such, the limitation of "an automation environment" is not present in Glorikan nor Fukui and therefor claims 1, 8, 9, 11, or 21 are not anticipated.

Each of claims 1, 8, 9, 11, and 21 contain the further limitation of "each network device is adapted to perform a designated function according to the physical location of said each network device". (In claims 8 and 9 the wording is slightly different, but contains a similar meaning.) The Examiner notes that this limitation is not present in Glorikian, and looks to Fukui for this limitation. However, Fukui does not contain the concept of designating the function according to the physical location. Instead, the function in Fukui comes from the passenger's designation of the function, not from the physical location. In Fukui column 4 line 11-16, it say

PATENT  
APPLICATION NO. 09/553,941

"Through the passenger control sets 18, a passenger has access to one or more services such as audio and video on demand, video games, gambling, telephone service and information services. Each passenger control set of seat peripherals 18 includes a set of peripherals which allow the passenger to access the features and services available through the system." Since the passenger designates the functionality, the functionality is not determined by the physical location of the device as required by an automation environment, as required by claims 1, 8, 9, 11, and 21, and is therefore not anticipated.

Furthermore, claims 1, 8, and 9 contain the limitation of "...designated functions can be carried out in a coordinated way as required in an automation environment". Neither Glorikan nor Fukui contains references to "an automation environment" (see above) nor to the coordination of automation functions. The Examiners arguments that the working of a GPS transceiver somehow is the same as the coordination of automation functions is simply not topical. An automation environment is coordinated as described on pages 5 and 6 of the present application, and is very different from the GPS functionality of Glorikan that is used in the Examiner's argument. As such, this limitation is not present in the cited references and therefore these references can not anticipate claims 1, 8, or 9.

Claims 8 and 9 require a programmable logic controller. The Examiner cites to a reference in Fukui that discusses a passenger control unit. A passenger control unit is not the same as a programmable logic controller. Neither Glorikan nor Fukui disclose a programmable logic controller, so these claims can not be anticipated.

Claim 9 contains a further limitation of "wherein at least one of the devices comprises an I/O device of a programmable logic controller system". There are no references in either

PATENT  
APPLICATION NO. 09/553,941

Glorikan not Fukui to an I/O device of a programmable logic controller system. As a result, this claim can not be anticipated.

Moreover, the Office Action has failed to provide a motive or incentive as to why it would have been obvious to combine Glorikan with Fukui. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). When the motivation to combine the teachings of the references is not immediately apparent, an explanation is required as to why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986). Applicants respectfully submit that because a suggestion or motivation to combine the cited references has not been shown, a prima facie case of obviousness has not been made. The Examiner's contention that Fukui and Glorikan are from the same field of endeavor is not supported nor is it factual. As noted above, Glorikan is from the Internet and business methods field and Fukui is from the in-flight entertainment field. Each is from a very different field and both are different from the automation field.

Instead, isolated features from the cited references have been used with the claims of the present application as a template. Such hindsight reconstruction is improper. It is well recognized that the claimed invention cannot be used as an instruction manual or template to piece together the teachings of the prior art in an attempt to render the claimed device obvious. *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992); *Fine*, 837 F.2d at 1075 (Stating that "one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.")

PATENT  
APPLICATION NO. 09/553,941

The Office Action fails to meet its initial burden of factually supporting any *prima facie* conclusion of obviousness. See MPEP § 2142. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. As discussed above, there is no suggestion to combine. Second, there must be a reasonable expectation of success. Finally, the prior art reference(s) must teach or suggest all of the claim limitations. As discussed above, there are many missing claim limitations. The teaching or suggestion to make the claimed combinations and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The Office Action merely concludes that the combination is obvious and fails to show a teaching or motivation in the prior art to combine features of Glorikan with Fukui in the manner suggested in the rejection of claims 1, 8, 9, 11 and 21. See *In Re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999) (Confirming that "[o]ur case law makes clear that the best defense against the subtle but powerful attraction of hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."). Clear and particular evidence is required to be provided showing why one skilled in the art would combine the references in the manner suggested. *In Re Dembiczak*, 175 F.3d at 999 (Stating that "[t]he range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular."). Instead, the Office Action merely infers as to what the prior art would suggest to one of ordinary skill in the art. Such unsupported inferences regarding teaching or motivation, are insufficient. *In Re Dembiczak*, 175 F.3d at 999 (Providing that "[b]road conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'").

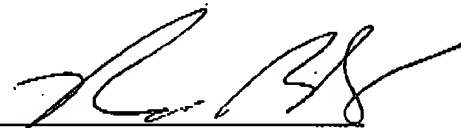
PATENT  
APPLICATION NO. 09/553,941

As for claims 2-5, 12-20 and 22-27, they are dependent from claims 1, 11 and 21 and recite features not recited in claims 1, 11 and 21. For reasons regarding claims 1, 11 and 21 above, it is respectfully submitted that claims 2-5, 12-20 and 22-27 are also distinguishable over the *Glorikian* and *Fukui* references (the rejections of claims 19, 20, and 23 also include the combination of additional references, but these additional references do not disclose the limitations missing from the independent claims).

## CONCLUSION

Applicant has amended the claims 1, 8, 9, 11 and 21 and has added claim 28-30 and has shown why claims 1-5, 8, 9, and 11-30 are allowable. As such, Applicant requests that the rejections be removed, and that this case be allowed to issue. The commissioner is authorized to charge deposit account 19-3875 (SAA-36) for any fees associated herein.

Respectfully submitted,



Richard A. Baker, Jr.  
Inventor and Patent Agent Reg. 48,124

Square D. Company  
1415 South Roselle Road  
Palatine, IL 60067  
Telephone No.: (978) 975-9789  
Fax No.: (847) 925-7419